REMARKS

Claims 1 through 16 remain in the application.

Claim 1 through 16 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection.

An analysis of whether the claims are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (C.C.P.A. 1976).

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)(Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

Thus, the dispositive issue is whether Applicants' disclosure, considering the level of ordinary skill in the art as of the date of Applicants' application, would have enabled a person of such skill to make Applicants' invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the Examiner has met his burden

of proof by advancing acceptable reasoning inconsistent with enablement. This the Examiner has not done.

The specification clearly states, on page 14, line 13 through page 15, line 2, that:

> In block 205, the user 126 determines specific program requirements related to the vehicle design 128 of the vehicle 10 and selects an information database for decision making purposes from an information portal displayed on the video terminal 124b. An example of a program requirement is information maintained within the knowledge-based library 112 regarding the type of vehicle 10 to be designed, such as passenger car or truck. Another example of a program requirement is anticipated production volume, or vehicle body style. Still another example of a program requirement is a warranty target. Advantageously, the user 126 may select a program requirement from an information portal screen displayed on the display terminal 124b containing a list of program requirements.

Based on the above, the specification adequately describes vehicle program requirements and that the information is maintained within the knowledge-based library. One skilled in the art would clearly have sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

Further, the specification clearly states, on page 15, lines 12 through 26, that:

> In diamond 210, the methodology determines if the information from the information database correlates with the program requirements. For example, the information may be compared to the program requirements to determine if there is a change in a component part that would affect the use of the information in making an informed decision regarding the vehicle design 128. The information may also be compared to the program requirements to determine if there is a design or manufacturing process change that would affect the use of the information.

Based on the above, the specification adequately describes determining if the information from the information database correlates with the program requirement. One skilled

in the art would clearly have sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

Moreover, the specification clearly states, on page 16, lines 3 through 6, that:

> In block 215, the methodology uses the information from the information database in making an informed decision regarding the design of the vehicle 10.

Based on the above, the specification adequately describes using the information from the information database in the design of the vehicle. One skilled in the art would clearly have sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. It is respectfully submitted that claims 1 through 16 are allowable over the rejection under 35 U.S.C. § 112, first paragraph.

Claims 1 through 16 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectively traverse this rejection.

The first paragraph of Section 112 provides that "the specification shall contain a written description of the invention . . .". "The description requirement's purposes are to assure that the applicant was in full possession of the claimed subject matter on the application filing date and to allow other inventors to develop and obtain patent protection for later improvements and subservient inventions that build on applicant's teachings." See In re Barker, 559 F.2d 588, 194 U.S.P.Q. 470 (C.C.P.A 1977), cert. denied, 434 U.S. 1064 (1978); Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991); and In re Dossel, 115 F.2d 942, 42 U.S.P.Q.2d 1881 (Fed. Cir. 1997).

Thus, the dispositive issue is whether Applicants' disclosure in the patent application relied upon "reasonably conveys to the artisan that the inventor had possession at the

time of the later claimed subject matter". The threshold step in resolving this issue as set forth

supra is to determine whether the Examiner has met his burden of proof by advancing acceptable

reasoning inconsistent with the written description. This the Examiner has not done.

The specification clearly states, on page 14, line 13 through page 15, line 2, that:

In block 205, the user 126 determines specific program requirements
related to the vehicle design 128 of the vehicle 10 and selects an
information database for decision making purposes from an
information portal displayed on the video terminal 124b. An example
of a program requirement is information maintained within the
knowledge-based library 112 regarding the type of vehicle 10 to be
designed, such as passenger car or truck. Another example of a
program requirement is anticipated production volume, or vehicle
body style. Still another example of a program requirement is a
warranty target. Advantageously, the user 126 may select a program
requirement from an information portal screen displayed on the
display terminal 124b containing a list of program requirements.

Further, the specification clearly states, on page 15, lines 12 through 26, that:

In diamond 210, the methodology determines if the information from
the information database correlates with the program requirements.
For example, the information may be compared to the program
requirements to determine if there is a change in a component part
that would affect the use of the information in making an informed
decision regarding the vehicle design 128. The information may also
be compared to the program requirements to determine if there is a
design or manufacturing process change that would affect the use of
the information.

In addition, the specification clearly states, on page 16, lines 3 through 6, that:

In block 215, the methodology uses the information from the
information database in making an informed decision regarding the
design of the vehicle 10.

Based on the above, Applicants' disclosure reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter. Contrary to the Examiner's assertion, Applicants' have adequately described program requirement, library, correlates, and using the information. Finally, an artisan would reasonably understand from the Specification and drawings as a whole, what the program requirements are, that the information is in the knowledge-based library, that the information is compared to correlate it, and that the information is used by an operator to make an informed decision. Therefore, it is respectfully submitted that claims 1 through 16 are allowable over the rejection under 35 U.S.C. § 112, first paragraph.

Claims 1 through 16 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses this rejection.

Claims 1 through 16 are clear and definite as to the program requirement, library, correlates, and using the information. Such terms or phrases are interpreted in light of the specification. As to claim 2, claim 2 is clear and definite. The specification states on page 16, lines 10 through 13, that the user 126 determines if additional information from another database is available to assist in determining if the information database correlates with the program requirements. As such, the term "additional" is not needed and would be inaccurate if added to claim 2 as suggested by the Examiner. Therefore, it is respectfully submitted that claims 1 through 16 are allowable over the rejection under 35 U.S.C. § 112, second paragraph.

Claim 1 was rejected under 35 U.S.C. § 103 as being unpatentable over Juran (Juran on Quality by Design) in view of Tucker (The Computer Science and Engineering Handbook). Claims 2 through 6 were rejected under 35 U.S.C. § 103 as being unpatentable over Juran in view of Tucker. Applicants respectfully traverse both rejections.

The publication "Juran on Quality by Design" to Juran discloses new steps for planning quality into goods and services. A data base is a body of information derived from prior cycles of activity, and organized to aid in the conduct of future cycles. Data bases are the result of lessons learned from human experience. These lessons learned are then stored in memories to be used as needed. Figure 12-1 sets out the critical aspects of construction and use of data bases and the associated consequences. With respect to quality, the upper managers concluded that Taurus should be "Best in Class": the quality should be equal or superior to that of any competing model in the "class," domestic or foreign. Juran does not disclose the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. Juan also does not disclose that a library is accessed through an information portal on a computer system and an information database is accessed through the information portal.

The publication "The Computer Science and Engineering Handbook" to Tucker discloses the World Wide Web (WWW) is the fastest-growing protocol on the Internet. Tucker does not disclose a method of integrating product information management with vehicle design. Tucker also does not disclose selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle.

In contradistinction, claim 1 claims the present invention as a method of integrating product information management with vehicle design. The method includes the steps

of selecting a vehicle program requirement from a library stored in a memory of a computer system, wherein the library is accessed through an information portal on the computer system. The method also includes the steps of selecting an information database containing information related to the design of the vehicle from the library, wherein the information database is accessed through the information portal. The method includes the steps of determining if the information from the information database correlates with the program requirement. The method further includes the steps of using the information from the information database in the design of the vehicle, if the information from the information database correlates with the program requirement.

The United States Court of Appeals for the Federal Circuit (CAFC) has stated in determining the propriety of a rejection under 35 U.S.C. § 103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). The law followed by our court of review and the Board of Patent Appeals and Interferences is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976). See also In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.")

None of the references cited, either alone or in combination with each other, teach or suggest the claimed invention of claim 1. Specifically, Juran merely discloses new steps for planning quality into goods and services in which a data base is a body of information derived from prior cycles of activity, and organized to aid in the conduct of future cycles. Juan lacks a library accessed through an information portal on a computer system and an information database accessed through the information portal. Juran also lacks the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. In Juran, the steps include the use of a data base, but do not include selecting a vehicle program requirement from a library, selecting an information database containing information related to the design of the vehicle from the library, and determining if the information from the information database correlates with the program requirement. Tucker merely discloses that the World Wide Web (WWW) is the fastest-growing protocol on the Internet. Tucker lacks a method of integrating product information management with vehicle design. Tucker also lacks selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. In Tucker, there is no integration of product information with vehicle design. There is no motivation in the art to combine Juran and Tucker together.

The references, if combinable, fail to teach or suggest the combination of a method of integrating product information management with vehicle design including the steps of

The references, if combinable, fail to teach or suggest the combination of a method of integrating product information management with vehicle design including the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, wherein the library is accessed through an information portal on the computer system, selecting an information database containing information related to the design of the vehicle from the library, wherein the information database is accessed through the information portal, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle, if the information from the information database correlates with the program requirement as claimed by Applicants. The claimed invention is novel and unobvious because the method of integrating product information management with vehicle design is provided that links together various existing databases, system infrastructure and information sources to provide a user with access to information contained therein to assist the user in informed decision making. Thus, the Examiner has failed to establish a case of prima facie obviousness. Therefore, it is respectfully submitted that claim 1 and the claims dependent therefrom are allowable over the rejections under 35 U.S.C. § 103.

Claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over Juran in view of Tucker. Claims 8 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over Juran in view of Tucker. Applicants respectfully traverse both rejections.

As to claim 7, claim 7 claims the present invention as a method of integrating product information management with vehicle design. The method includes the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, wherein the library is accessed through a web-based information portal on the computer system. The method also includes the steps of selecting an information database containing information

related to the design of the vehicle from the library, wherein the information database is accessed through the information portal. The method includes the steps of determining if the information from the information database correlates with the program requirement and using the information from the information database in the design of the vehicle, if the information from the information database correlates with the program requirement. The method further includes the steps of selecting through the information portal additional information for determining if the information from the information database correlates with the program requirement, if the information from the information database does not correlate with the program requirement. The method includes the steps of determining if a portion of the information from the information database correlates with the program requirement based on the additional information and using the portion of the information from the information database that correlates with the program requirement in the design of the vehicle.

None of the references cited, either alone or in combination with each other, teach or suggest the claimed invention of claim 7. Specifically, Juran merely discloses new steps for planning quality into goods and services in which a data base is a body of information derived from prior cycles of activity, and organized to aid in the conduct of future cycles. Juan lacks a library accessed through a web-based information portal on a computer system and an information database accessed through the information portal. Juran also lacks the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. Juran further lacks the steps of selecting through the information portal additional information for determining if the information from the information database correlates with the

program requirement, if the information from the information database does not correlate with the program requirement, determining if a portion of the information from the information database correlates with the program requirement based on the additional information, and using the portion of the information from the information database that correlates with the program requirement in the design of the vehicle. In Juran, the steps include the use of a data base, but do not include selecting a vehicle program requirement from a library, selecting an information database containing information related to the design of the vehicle from the library, and determining if the information from the information database correlates with the program requirement. Also in Juran, there is no selecting through the information portal additional information for determining if the information from the information database correlates with the program requirement, determining if a portion of the information from the information database correlates with the program requirement based on the additional information, and using the portion of the information from the information database that correlates with the program requirement in the design of the vehicle.

Tucker merely discloses that the World Wide Web (WWW) is the fastest-growing protocol on the Internet. Tucker lacks a method of integrating product information management with vehicle design. Tucker also lacks selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. Tucker further lacks selecting through the information portal additional information for determining if the information from the information database correlates with the program requirement, if the information from the information database does not correlate with the program requirement, determining if a

portion of the information from the information database correlates with the program requirement based on the additional information, and using the portion of the information from the information database that correlates with the program requirement in the design of the vehicle. In Tucker, there is no integration of product information with vehicle design. There is no motivation in the art to combine Juran and Tucker together.

The references, if combinable, fail to teach or suggest the combination of a method of integrating product information management with vehicle design including the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, wherein the library is accessed through a web-based information portal on the computer system, selecting an information database containing information related to the design of the vehicle from the library, wherein the information database is accessed through the information portal, determining if the information from the information database correlates with the program requirement, using the information from the information database in the design of the vehicle, if the information from the information database correlates with the program requirement, selecting through the information portal additional information for determining if the information from the information database correlates with the program requirement, if the information from the information database does not correlate with the program requirement, determining if a portion of the information from the information database correlates with the program requirement based on the additional information, and using the portion of the information from the information database that correlates with the program requirement in the design of the vehicle as claimed by Applicants. The claimed invention is novel and unobvious because the method of integrating product information management with vehicle design is provided that links together various existing databases, system infrastructure and information sources to provide a user with access to information contained therein to assist the user in informed decision making.

Further, the CAFC has held that "[t]he mere fact that prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification". In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The Examiner has failed to show how the prior art suggested the desirability of modification to achieve Applicants' invention. Thus, the Examiner has failed to establish a case of prima facie obviousness. Therefore, it is respectfully submitted that claim 7 and the claims dependent therefrom are allowable over the rejections under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over Juran in view of Tucker. Claims 11 through 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Juran in view of Tucker. Applicants respectfully traverse both rejections.

As to claim 10, claim 10 claims the present invention as a method of integrating product information management with vehicle design to verify existing information, using a computer system having a memory, a display device and a user interactive device. The method includes the steps of selecting a vehicle program requirement for the design of the vehicle from a library stored in a memory of the computer system, wherein the library is access through a web-based information portal displayed on the display device. The method also includes the steps of selecting an information database of verification information for the design of the vehicle, wherein the information database is accessed through the information portal. The method includes the steps of determining if the verification information from the information database correlates with the program requirement and using the information database in the design of the vehicle if the verification information correlates with the program requirement. The method further includes the steps of selecting through the information portal additional information regarding the design of the vehicle and using the additional information to determine if a portion of the verification information correlates with the program requirement. The method includes the

steps of using the portion of the verification information that correlates with the program requirement if determined that a portion of the verification information correlates with the program requirement. The method further includes the steps of generating new information if a portion of the verification information does not correlate with the program requirement.

None of the references cited, either alone or in combination with each other, teach or suggest the claimed invention of claim 10. Specifically, Juran merely discloses new steps for planning quality into goods and services in which a data base is a body of information derived from prior cycles of activity, and organized to aid in the conduct of future cycles. Juan lacks a library accessed through a web-based information portal on a computer system and an information database accessed through the information portal. Juran also lacks the steps of selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. Juran further lacks the steps of selecting through the information portal additional information regarding the design of the vehicle and using the additional information to determine if a portion of the verification information correlates with the program requirement, using the portion of the verification information that correlates with the program requirement if determined that a portion of the verification information correlates with the program requirement, and generating new information if a portion of the verification information does not correlate with the program requirement. In Juran, the steps include the use of a data base, but do not include selecting a vehicle program requirement from a library, selecting an information database containing information related to the design of the vehicle from the library, and determining if the information from the information database correlates with the program requirement. Also in

Juran, there is no selecting through the information portal additional information regarding the design of the vehicle and using the additional information to determine if a portion of the verification information correlates with the program requirement, using the portion of the verification information that correlates with the program requirement if determined that a portion of the verification information correlates with the program requirement, and generating new information if a portion of the verification information does not correlate with the program requirement.

Tucker <u>merely</u> discloses that the World Wide Web (WWW) is the fastest-growing protocol on the Internet. Tucker lacks a method of integrating product information management with vehicle design. Tucker also lacks selecting a vehicle program requirement from a library stored in a memory of a computer system, selecting an information database containing information related to the design of the vehicle from the library, determining if the information from the information database correlates with the program requirement, and using the information from the information database in the design of the vehicle. Tucker further lacks selecting through the information portal additional information regarding the design of the vehicle and using the additional information to determine if a portion of the verification information correlates with the program requirement, using the portion of the verification information that correlates with the program requirement if determined that a portion of the verification information correlates with the program requirement, and generating new information if a portion of the verification information does not correlate with the program requirement. In Tucker, there is no integration of product information with vehicle design. There is no motivation in the art to combine Juran and Tucker together.

The references, if combinable, fail to teach or suggest the combination of a method of integrating product information management with vehicle design to verify existing

information including the steps of selecting a vehicle program requirement for the design of the vehicle from a library stored in a memory of the computer system, wherein the library is access through a web-based information portal displayed on the display device, selecting an information database of verification information for the design of the vehicle, wherein the information database is accessed through the information portal, determining if the verification information from the information database correlates with the program requirement, using the information database in the design of the vehicle if the verification information correlates with the program requirement, selecting through the information portal additional information regarding the design of the vehicle and using the additional information to determine if a portion of the verification information correlates with the program requirement, using the portion of the verification information that correlates with the program requirement if determined that a portion of the verification information correlates with the program requirement, and generating new information if a portion of the verification information does not correlate with the program requirement as claimed by Applicants. The claimed invention is novel and unobvious because the method of integrating product information management with vehicle design is provided that links together various existing databases, system infrastructure and information sources to provide a user with access to information contained therein to assist the user in informed decision making. Thus, the Examiner has failed to establish a case of prima facie obviousness. Therefore, it is respectfully submitted that claim 10 and the claims dependent therefrom are allowable over the rejections under 35 U.S.C. § 103.
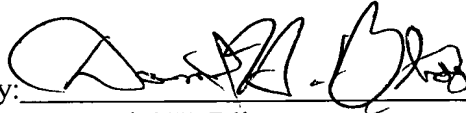
Obviousness under § 103 is a legal conclusion based on factual evidence (In re Fine, 837 F.2d 1071, 1073, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988), and the subjective opinion of the Examiner as to what is or is not obvious, without evidence in support thereof, does not suffice. Since the Examiner has not provided a sufficient factual basis, which is supportive of

his/her position (see <u>In re Warner</u>, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967), <u>cert. denied</u>, 389 U.S. 1057 (1968)), the rejections of claims 1 through 16 are improper. Therefore, it is respectfully submitted that claims 1 through 16 are allowable over the rejections under 35 U.S.C. § 103.

Based on the above, it is respectfully submitted that the claims are in a condition for allowance, which allowance is solicited.

Respectfully submitted,

By: _____
Daniel H. Bliss
Reg. No. 32,398

BLISS McGLYNN, P.C.
2075 West Big Beaver Road, Suite 600
Troy, Michigan   48084
(248) 649-6090

Date: _____

Attorney Docket No.: 0693.00199
Ford Disclosure No.: 199-1255